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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,870

Applicant(s)

INON, GAD

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/CB/CIC)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 10 and 22** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 22 recite the limitation "the guest" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1-7 and 11-19** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Malik (US 2003/0065768 A1) in view of Sagi et al. (US 6,865,384 B2)

and further in view of Anttila et al. (US 2003/0126211 A1).

Regarding **claim 1**, Malik discloses a method for initiating a session in a store and forward messaging system (FIG. 1 and paragraph 0029), said method comprising:

receiving a session connection request from a caller of the store and forward messaging system (paragraph 0086);

comparing the capability information of the device used by the caller to the capability information of the device used by the subscriber, wherein the capability information of the device used by the caller is compared to the capability information of the device used by the subscriber prior to the caller transmitting the message to the store and forward messaging system (paragraph 0088).

Malik fails to disclose determining a subscriber of the store and forward messaging system.

However, Sagi teaches determining a subscriber of the store and forward messaging system for whom the caller wishes to deposit a message (column 4, lines 9-55); and

retrieving capability information of a device used by the subscriber of the store and forward messaging system for whom the caller wishes to deposit a message (column 4, lines 9-55).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Malik using the teaching of subscriber profile as taught by Sagi.

This modification of the invention enables the system to determine a subscriber of the store and forward messaging system so that the user would receive the message in the desired format.

Malik in combination with Sagi fail to disclose determining capability information of a device used by the guest.

However, Anttila teaches determining capability information of a device used by the guest to connect to the store and forward messaging system (paragraph 0017).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Malik in combination with Sagi using the teaching of guest user terminal as taught by Anttila.

This modification of the invention enables the system to determine capability information of a device used by the guest so that the user would receive the message in the desired format.

Regarding **claim 2**, Malik discloses a method for initiating a session, wherein, if at least a portion of the capability information of the device used by the guest matches a portion of the capability information of the device used by the subscriber, the portion of the capability information that matches is presented to the guest (paragraph 0086).

Regarding **claims 3 and 12**, Malik discloses a method for initiating a session, wherein if at least a portion of the capability information of the device used by the guest does not match at least a portion of the capability information of the device used by the subscriber, a default capability information is presented to the guest (paragraph 0086).

Regarding **claims 4 and 14**, Malik discloses a method for initiating a session, wherein the guest transmits the message to the store and forward system using at least the portion of capability information that matches (paragraph 0086).

Regarding **claims 5 and 10**, Malik discloses a method for initiating a session, wherein the capability information comprises at least one of the following: a video codec, a rate of video codec, an audio codec, a rate of audio codec, a screen size of the device used by the guest or subscriber, and colors supported by the device used by the guest or subscriber (paragraph 0087).

Regarding **claims 6, 13 and 16**, Malik discloses a method for initiating a session, wherein, if at least a portion of the capability information of the device used by the guest does not match at least a portion of the capability information of the device used by the subscriber, a default capability information is presented to the guest (paragraph 0087).

Regarding **claims 7, 15, 17 and 22**, Malik discloses a method for initiating a session, wherein the capability information comprises at least one of the following: a video codec, a rate of video codec, an audio coder, a rate of audio codec, a screen size of the device used by the guest or subscriber, and colors supported by the device used by the guest or subscriber (paragraph 0087).

Regarding **claim 11**, Malik in combination with Sagi and Anttila disclose all the limitations of claim 11 as stated in claim 1's rejection. Furthermore Malik disclose a receiving unit (114 on FIG. 1), a server (116 on FIG. 1) and a data storage unit (120 on FIG. 1).

Regarding **claim(s) 18**, Malik discloses a store and forward messaging system, further comprising: a transcoding unit that is able to convert a message deposited by the guest to a format supported by the device used by the subscriber if at least a portion of the capability information of the device used by the guest does not match at least a portion of the capability information stored in the data storage unit regarding the device of the subscriber for whom the guest wishes to deposit a message (paragraph 0086).

Regarding **claim(s) 19**, Malik discloses a store and forward messaging system, wherein the subscriber may maintain multiple accounts on the store and forward system, wherein each of the subscriber's accounts includes a different set of capability information (paragraph 0086).

7. **Claims 8, 9, 20 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik in view of Sagi.

Regarding **claim 8**, Malik discloses a method for initiating a session in a store and forward messaging system (FIG. 1 and paragraph 0029), said method comprising:

receiving a session connection request from a subscriber of the store and forward messaging system (paragraph 0072);

comparing the determined capability information of the device used by the subscriber to a stored device capability information of the subscriber in order to determine whether capability information has changed (paragraph 0071).

Malik fails to disclose determining a subscriber of the store and forward messaging system.

However, Sagi teaches determining capability information of a device used by the subscriber to connect to the store and forward messaging system (column 4, lines 9-55).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Malik using the teaching of subscriber profile as taught by Sagi.

This modification of the invention enables the system to determine a subscriber of the store and forward messaging system so that the user would receive the message in the desired format.

Regarding **claim 9**, Malik discloses a method for initiating a session, wherein, if it is determined that the capability information has changed, or it is the first time the subscriber has called into the store and forward messaging system, or that the capability information of the device used by the subscriber was initialized, then the stored device capability information of the subscriber is replaced by the determined capability information of the device used by the subscriber to connect to the store and forward messaging system (paragraph 0086).

Regarding **claim 20**, Malik in combination with Sagi disclose all the limitations of claim 20 as stated in claim 8's rejection above. Furthermore Malik discloses a receiving unit (114 on FIG. 1), a server (116 on FIG. 1) and a data storage unit (120 on FIG. 1).

Regarding **claim 21**, Malik discloses a store and forward messaging system, wherein, if it is determined that the capability information has changed, the capability information stored in the data storage unit is replaced with the capability information of

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the device used by the subscriber to connect to the store and forward messaging system (paragraph 0086).

Response to Arguments

8. Applicant's arguments with respect to **claims 1-22** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/
Primary Examiner, Art Unit 2614

GG
March 16, 2008